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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF APPEALS AND INTERFERENCES

Application of Mikhail Lotvin and Richard M. Nemes

Appl. No.: 10/790,991

Filed: 03/02/2004

Title: Computer systems and methods supporting on-line interaction with content, purchasing, and searching

Group/Art Unit: 3622

Examiner: BOVEJA, NAMRATA

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REPLY BRIEF

This is a reply to Examiner's Answer dated 03/15/10 to Applicants' Appeal Brief filed in the above application.

The Answer continues to assert that the independent claims are rejected as obvious in view of two references and two Official Notices. More references come into play when Examiner rejects the dependent claims. This conglomeration of fragments, loosely connected by conclusory one-sentence statements asserting obviousness, clearly demonstrates that the rejection is an exercise in hindsight.

Examiner provided a reference (the Flynn patent) for one of the Official Notices relied upon in the rejection. However, this patent has been filed in November 23, 1999, which is after the effective filing date of the present application

and, thus, it does not support the prior art status of the Official Notice. (It claims priority to an earlier-filed provisional application, but what is disclosed in the provisional is not mentioned in the Answer). Further, the Flynn reference relates to notifying about downloading, which is not in the claims at issue. The other Official Notice remains without any support, including the date of the alleged facts.

In addition to using a multitude of references and Official Notices, for certain claims, the doctrine of inherent disclosure is also used to come up with an obviousness argument. With respect to claims 28 and 85, the ValuPage reference is alleged to only inherently disclose "specifying an expiration date." In fact, as discussed in the Appeal Brief, ValuPage does not address the expiration date at all, but merely shows the amount of the savings offered during a given week. And, nothing in ValuPage precludes the same savings to be available during the following week as well. This reference plainly does not disclose an expiration of an offer. Further, Examiner simply modifies references to fit the goal. See, for example, page 8, lines 11-12 of the Answer where the Examiner redesigns the ValuPage art by stating that the disclosed website "could have easily been pasted in the body of the e-mail message."

On page 11 of the Answer, Examiner misunderstands Applicants' argument by assuming that Applicant argues that Obendorf does not suggest a purchasing selection fulfilled by a third party. Applicants argue that the entire purchasing transaction in Obendorf is performed by a third party. Thus, the step of "electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection" cannot be performed by the Obendorf system, because in the Obendorf system the selection is already performed at the third party.

On page 12, the Answer makes legally erroneous statements. It states that "one cannot show nonobviousness by attacking references individually where the rejection is based on the combination of references." (Answer, page 12 lines 3-4). Doubtless, if a step or element of the claim is not disclosed at all by any of the references, the claim is patentable. On the same page, the Examiner argues that it is irrelevant that the Kamakura reference teaches away from the ValuPage references because "the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." The present claims, however, have been rejected based on obviousness and the fact that the references teach away from their combination is highly relevant.

CONCLUSION

As discussed in the Appeal Brief and above the rejected claims are patentable.

Appellants respectfully request that the Examiner's rejection of claims 27, 28, 75-77, 79-85 be reversed.

Respectfully submitted,

May 14, 2010

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